

ARGUMENTS/REMARKS

Applicants would like to thank the examiner for the careful consideration given the present application, and for the personal interview conducted on August 3, 2005. The application has been carefully reviewed in light of the Office action and interview, and amended as necessary to more clearly and particularly describe and claim the subject matter which applicants regard as the invention.

Claims 1-34 remain in this application. New claim 35 has been added.

Claims 1-7, 11-15, and 18-22, 32, and 34 were rejected under 35 U.S.C. §103(a) as being anticipated by Ausems *et al.* (U.S. 6,434,403) in view of Emmoft *et al.* (U.S. 6,424,845). Claims 8-10 were rejected under 35 U.S.C. §103(a) as being unpatentable over Ausems in view of Emmoft, and further in view of Applicants Admitted Prior Art. Claims 16-17, 30-31, and 33 were rejected as above in further view of Wood Jr. (U.S. 6,118,789). Claims 27-29 were rejected under 35 U.S.C. §103(a) as being unpatentable over Ausems in view of Musgrave. Claims 23-29 were rejected as above in further view of Musgrave (U.S. 6,483,930). For the following reasons, the rejections are respectfully traversed.

As discussed at the personal interview, the references do not teach a receiver for receiving "a broadcast radio program including program-accompanying data" as recited in claims 1 and 32. Furthermore, the references do not teach "broadcasting a radio program in broadcast mode for simultaneous reception by a plurality of portable radio receivers for play by the users of said receivers" as recited in claim 34.

As discussed at the personal interview, none of the references suggest any ability to receive radio programs that are *broadcast* to a receiver. The Examiner cites Emmoft, col. 5, lines 38-44, as teaching the downloading of sporting results, financial information, music, etc. However, a close reading of the reference makes clear that this information is only provided in response to a "request message" (see col. 5, line 38-39). Thus, it is not "broadcast" by the transmitter, but instead is transmitted only in response to a request. Thus, only the specific devices that *request* the information first will play it for the user. In contrast, it is known by those

skilled in the art that a "broadcast" of information is sent by the transmitter not in response to a request, but instead without any need for such request, so that all devices within range can receive and use that information. This is in contrast to "point-to-point" communication that is intended for a specific device and thus typically requires a request for information to be transmitted, as is taught by the reference.

None of the other cited references teach this capability. Accordingly, claims 1, 32 and 34 are patentable over the references. The remaining claims, which depend on one of claims 1, 32, and 34, are thus also patentable over the references for at least the same reasons as the parent claim.

Furthermore, the references do not teach the claim 1 limitation of "means for storing said filtered program-accompanying data in said radio receiver" or the claim 32 limitation of "means for storing DAB program-accompanying data" in a storage area, as also discussed at the personal interview.

In particular, the Examiner admits that Ausems does not teach "storing DAB program-accompanying data" and instead attempts to cite Emmoft as teaching this element of the claim. However, although the Examiner has identified some data stored by the Emmoft device, there is no suggestion of storing program-accompanying data that was included in a broadcast, because the reference does not suggest any broadcast or Digital Audio Broadcasting (DAB) capability or support. Accordingly, claims 1 and 32 are patentable over the references. Claim 33, which depends on claim 32, is patentable over the references for at least the same reasons.

Claim 34 also recites the step of "sending authorization data in broadcast mode as program-accompanying data". The Examiner fails to show where any reference teaches this element of claim 34. Hence, claim 34 is patentable over the references.

Claim 34 also recites "filtering the authorization data concerning the user of a particular one of the radio receivers in a filter in the particular radio receiver". The Examiner admits that Ausems does not teach this step, and thus appears to cite Emmoft as teaching this claim limitation. However, as discussed at the personal interview, the cited section does not discuss filtering, as recited by the claim. The

cited section merely discusses downloaded information, without any discussion of authorization data or filtering (authorization data is not a "call sign" or "identity code" as no authorization is taught as occurring via that data). Accordingly, claim 34 is patentable over the references for this reason as well.

Further, the Examiner has not provided the proper motivation for combining the references. The burden is on the Examiner to make a prima facie case of obviousness (MPEP §2142). To support a prima facie case of obviousness, the Examiner must show that there is some *suggestion* or *motivation* to modify the reference (MPEP §2143.01). The mere fact that references *can* be combined or modified, alone, is not sufficient to establish prima facie obviousness (*Id.*). The prior art must also suggest the *desirability* of the combination (*Id.*). The fact that the claimed invention is within the *capabilities* of one of ordinary skill in the art is not sufficient, by itself, to establish prima facie obviousness (*Id.*).

The Examiner has merely listed an advantage provided by the secondary reference as motivation. The Examiner has not provided specific motivation for adding the particular features of the secondary reference(s) to the primary reference, as required.

Merely listing an advantage or benefit of the combination is not sufficient, as some rationale for *combining* the references must be found in the references themselves, or drawn from a convincing line of reasoning based on established scientific principles practiced by one skilled in the art that some advantage or beneficial result would be produced by the combination (MPEP §2144).

"To reach a proper determination under 35 U.S.C. 103, the examiner must step backward in time and into the shoes worn by the hypothetical 'person of ordinary skill in the art' when the invention was unknown and just before it was made [and] the examiner must then make a determination whether the claimed invention 'as a whole' would have been obvious at that time to that person." (MPEP §2142, emphasis added). It is not proper to merely combine various elements from various references. The invention must be obvious "as a whole", not as a piecemeal combination of elements from various references.

Accordingly, the rejections for obviousness is not supported by the Office

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action and thus the rejections are improper, and should be withdrawn.

Furthermore, the Examiner has not provided the proper motivation for adding the features claimed to be AAPA. Even if admitted prior art, the Examiner must provide the proper motivation for adding the feature to the primary reference. As discussed above, such motivation cannot be merely a benefit. In addition, such motivation cannot be found in the application itself, as such hindsight is impermissible; the facts must be gleaned from the prior art. (MPEP §2142, last paragraph). Yet, the Examiner cites benefits of the AAPA that can only be obtained from the application itself. Thus, the Examiner has failed to provide the proper motivation, and thus the rejection is improper.

In consideration of the foregoing analysis, it is respectfully submitted that the present application is in a condition for allowance and notice to that effect is hereby requested. If it is determined that the application is not in a condition for allowance, the examiner is invited to initiate a telephone interview with the undersigned attorney to expedite prosecution of the present application.

If there are any additional fees resulting from this communication, please charge same to our Deposit Account No. 16-0820, our Order No. 34225

Respectfully submitted,

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